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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,781	03/24/1999	HERBERT PEIFFER	07456.0009	8886

22852 7590 07/02/2002

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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

20

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/274,781

Applicant(s)

PEIFFER ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

1. Claim 7 has been cancelled by Applicant.
2. The finality of the previous Office Action has been withdrawn in favor of the new grounds of rejection, in view on newly discovered prior art. Any inconvenience to the Applicant is regretted.

### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 6/6/2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,054,212 has been reviewed and is accepted. The terminal disclaimer has been recorded.
4. The double patenting rejections based on U.S. Patent No. 6,054,212 in paragraph 3 of the previous Office Action have been withdrawn in view of Applicant's terminal disclaimer.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-6, 8-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 09/922,615 (PEIFFER ET AL) *or* claims 1-14 of copending Application No. 09/922,674 (PEIFFER ET AL), in view of KIMURA ET AL (US 5,747,174) and ULLMANN'S ENCYCLOPEDIA OF INDUSTRIAL CHEMISTRY (hereinafter ULLMANN'S).

Application Nos. 09/922,615 and 09/922,674 (PEIFFER ET AL) claim multilayer polyester films having base layers, outer layers, and oxygen permeability as recited in Application 09/274,781 (claims 1-17), wherein the films are further coated and/or metallized. However, the Applications do not explicitly claim films with the recited functional coating thicknesses or surface tension.

KIMURA ET AL discloses that it is well known in the art to surface treat multilayer polyester film such that the film has a surface tension of not less than 40 dynes/cm (lines 54-68, col. 8) prior to application of a functional coating such as an metal oxide or polymeric barrier layer and adhesion promoting layers (lines 31-53, col. 6) in order to obtain films with strongly adhered coatings, wherein the film is suitable for packaging, printing and other conventional applications using polyester film as recited in Application 09/274,781 claims 1, 14-15, 18, 21-23.

ULLMANN'S discloses that it is well known in the art to surface treat multilayer polyester film prior to application of a functional coating such as adhesion promoting layers

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(Section 2.4) in order to obtain films with strongly adhered coatings, wherein the film is suitable for packaging, printing, photography, and other conventional applications using polyester film (Section 7) as recited in Application 09/274,781 claims 1, 14-15, 18-23. The reference further discloses conventional methods of forming multilayer biaxially oriented films (Sections 2.2-2.3) as recited in Application 09/274,781 claim 17.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a functional coating to the film claimed in Application Nos. 09/922,615 and 09/922,674 (PEIFFER ET AL) and to adjust the thickness of said functional coating as indicated in claims 1, 15 depending on the type of coating material and the desired physical property in order to produce films suitable for use as substrates in printing, packaging, and photographic applications.

This is a provisional obviousness-type double patenting rejection.

7. Claims 1-6, 8-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,391,410 (PEIFFER ET AL) *or* claims 1-22 of U.S. Patent No. 6,149,995 (PEIFFER ET AL), in view of KIMURA ET AL (US 5,747,174) and ULLMANN'S ENCYCLOPEDIA OF INDUSTRIAL CHEMISTRY (hereinafter ULLMANN'S).

Patent Nos. 6,391,410 and 6,149,995 (PEIFFER ET AL) claim multilayer polyester films having base layers, outer layers, and oxygen permeability as recited in Application 09/274,781 (claims 1-17), wherein the films are further coated and/or metallized. However, the Applications do not explicitly claim films with the recited functional coating thicknesses or surface tension.

KIMURA ET AL discloses that it is well known in the art to surface treat multilayer polyester film such that the film has a surface tension of not less than 40 dynes/cm (lines 54-68, col. 8) prior to application of a functional coating such as an metal oxide or polymeric barrier layer and adhesion promoting layers (lines 31-53, col. 6) in order to obtain films with strongly adhered coatings, wherein the film is suitable for packaging, printing and other conventional applications using polyester film as recited in Application 09/274,781 claims 1, 14-15, 18, 21-23.

ULLMANN'S discloses that it is well known in the art to surface treat multilayer polyester film prior to application of a functional coating such as adhesion promoting layers (Section 2.4) in order to obtain films with strongly adhered coatings, wherein the film is suitable for packaging, printing, photography, and other conventional applications using polyester film (Section 7) as recited in Application 09/274,781 claims 1, 14-15, 18-23. The reference further discloses conventional methods of forming multilayer biaxially oriented films (Sections 2.2-2.3) as recited in Application 09/274,781 claim 17.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a functional coating to the film claimed in Application Nos. 09/922,615 and 09/922,674 (PEIFFER ET AL) and to adjust the thickness of said functional coating as indicated in claims 1, 15 depending on the type of coating material and the desired physical property in order to produce films suitable for use as substrates in printing, packaging, and photographic applications.

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*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

June 27, 2002



Vivian Chen  
Primary Examiner  
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